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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,628	06/26/2006	Naoyuki Onoda	10993.0272	9660
22852	7590	07/30/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER ROBINSON, CHANCEITY N	
			ART UNIT	PAPER NUMBER
			1795	
			MAIL DATE	DELIVERY MODE
			07/30/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/584,628

Applicant(s)

ONODA ET AL.

Examiner

CHANCEITY N. ROBINSON

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) 10-12 and 14-16 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 and 13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 06/26/2008
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Election/Restrictions

2. Applicant's election without traverse of Group I, claims 1-9 and 13, filed on April 27, 2009 is acknowledged. Claims 10-12 and 14-16 are withdrawn from further consideration.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claim 13 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fan (US 5,719,009).

Claim 13 is a product-by-process claim. Claim 13 includes the claim language, "water-developable photopolymer plate for letterpress printing produced by the method..." which is considered product-by-process claim language.

Applicant is reminded of MPEP2113: "[E]ven though product-by-process claims are limited by and defined by the process; determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claim 13, Fan discloses a water-developable photopolymer plate for letterpress printing. See column 1, lines 23-24 and example 10. The water-developable photopolymer plate of Fan is considered to be the same as the applicant's water-developable photopolymer plate, absent any evidence to the contrary.

7. Claim 13 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Haraguchi et al. (US 2002/0034706).

Claim 13 is a product-by-process claim. Claim 13 includes the claim language, "water-developable photopolymer plate for letterpress printing produced by the method..." which is considered product-by-process claim language.

Applicant is reminded of MPEP 2113: "[E]ven though product-by-process claims are limited by and defined by the process; determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claim 13, Haraguchi et al. disclose a water-developable photopolymer plate for letterpress printing. See abstract. The water-developable photopolymer plate of Haraguchi et al. is considered to be the same as the applicant's water-developable photopolymer plate, absent any evidence to the contrary.

8. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsumiya et al. (JP2002-292985).

Regarding claims 1-9, Matsumiya et al. disclose a method for producing a water-developable photopolymer plate for letterpress printing comprising an exposure step, a development step and post-exposure step. See paragraphs [0001 & 0027] Matsumiya et al. disclose the photopolymer plate is brought into contact with a liquid (developer) comprising a modified silicone compound and/or a modified fluorine compound during or after exposure step. See paragraphs 16-17 and examples. The photopolymer comprises a binder polymer comprising

a polar group-containing polymer and a hydrophobic polymer; an ethylenically unsaturated compound; and a photopolymerization initiator. See paragraphs 0018-0025.

9. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Yokoyama (EP0539227 A1).

Regarding claims 1-9, Yokoyama discloses a method for producing a water-developable photopolymer plate for letterpress printing comprising an exposure step, a development step and post-exposure step (abstract and page 2, lines 1-13). Yokoyama discloses the photopolymer plate is brought into contact with a liquid (developer) comprising a modified silicone compound and/or a modified fluorine compound during or after exposure step (page 2, line 52- page 3, line 13 & page 4, lines 5-9). The photopolymer comprises a binder polymer comprising a polar group-containing polymer and a hydrophobic polymer; an ethylenically unsaturated compound; and a photopolymerization initiator (page 3, lines 22-24 and examples 1-4).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHANCEITY N. ROBINSON whose telephone number is (571)270-3786. The examiner can normally be reached on Monday to Thursday: 7:30 am-6:00 pm eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chanceity N Robinson/
Examiner, Art Unit 1795

/Cynthia H Kelly/
Supervisory Patent Examiner, Art Unit 1795